

Appl. No. 10/576,918  
Amdt. Dated: Feb. 14, 2008  
Reply to Office action of September 14, 2007

### **REMARKS/ARGUMENTS**

Claims 1-17 are currently pending. Claims 8-17 have been withdrawn from consideration by the Examiner as a result of a restriction requirement. Claim 1 has been amended to further clarify the claim. Applicants submit that no new matter has been added as a result of this amendment.

### **Restriction Requirement**

Applicants affirm the election of Group I, Claims 1-7, and  $^{11}\text{C}$  isotope as the species for examination. Applicants understand that if the elected species is found allowable, the Office will expand the search to cover other isotopes of carbon.

### **Rejection under 35 U.S.C. 102(e)**

35 U.S.C. § 102(e) recites:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

The Office rejects claims 1-7 under 35 U.S.C. § 102(e) as being anticipated by Kihlberg et al (WO 02/102711 A1) (“Kihlberg”). On page 6 of the Office Action, the Office states :

Kihlberg et al disclose a method and apparatus for the production and use of  $^{11}\text{C}$  carbon monoxide enriched gas-mixture from carbon-isotope dioxide. Further, Kihlberg teaches the utilization of carbon-isotope dioxide in the labeling

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synthesis to produce  $^{11}\text{C}$  carbon monoxide enriched gas-mixture in a reaction chamber as embodied in the instant claims thus anticipating the instant claims.

Applicants respectfully disagree with and traverse this rejection. Anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986). *Moba B.V. v. Diamond Automation Inc.*, 66 USPQ2d 1429, 1440 (Fed. Cir. 2003). Applicants respectfully submit that the Office has failed to show that all of the claim limitations are taught by the prior art. Specifically, although the Office acknowledges that the instant claims comprise “(a) a UV reactor assembly” and “(e) UV lamp” on page 6 of the Office Action, the Office fails to articulate where these limitations are discussed in Kihlberg. Indeed, Kihlberg fails to disclose the use of ultraviolet radiation in the labeling reactions described therein.

Kihlberg describes a system and method for the production and use of a carbon-isotope monoxide in the synthesis of  $^{11}\text{C}$ -labeled compounds using [ $^{11}\text{C}$ ] monoxide in palladium or selenium mediated reactions. See Kihlberg, page 16, and the instant specification page 3, lines 22-30. Kihlberg does not describe the presence of a UV reactor assembly, i.e., the presence of a UV lamp, a concave mirror, and a window in the high pressure reaction chamber facing the concave mirror. Thus, claims 1-7 are not anticipated by Kihlberg.

Further, because the reactions of Kihlberg and Rahman are palladium catalyzed, there would be no reason why one of ordinary skill in the art would modify the assembly of Kihlberg with UV components, since application of UV radiation would generate free

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radicals (*see* specification, page 24, lines 1-5), a completely different mechanism than the palladium catalyzed reaction. Therefore, claims 1-7 are patentable over Kihlberg.

### **Double Patenting**

Claims 1-7 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-7 of copending Application No. 11/268,107 (“the ‘107 application”). The Office alleges that the claims are not patentably distinct because claims 1-7 of the instant application are “well within the scope of Claim[sic] of the base claim 1 and specifically claim 2-5 of the copending application.”

In response, Applicants note that M.P.E.P § 804 recites:

If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer.

In the instant case, the present application is a 371 of PCT/IB04/03488 filed on October 25,

2004, which is earlier than the filing date of 11/268,107, filed on November 7, 2005.

Applicants respectfully submit that in view of the above remarks, the obviousness double patenting rejection is the only rejection remaining in this case. Therefore, Applicants respectfully submit that the double patenting rejection should be withdrawn.

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**CONCLUSION**

For all the reasons set forth above, an indication of allowance of all claims is solicited. In the event any outstanding issues remain in the Application, the Examiner is more than welcome to telephone the undersigned counsel to resolve any such issues in the interest of expediency and to further place the application in condition for allowance.

Respectfully submitted,

/Robert F. Chisholm/  
Robert F. Chisholm  
Reg. No. 39,939

GE Healthcare, Inc.  
101 Carnegie Center  
Princeton, NJ 08540  
Phone (609) 514-6418

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